

II. REJECTION UNDER 35 U.S.C. § 112

Further to the Examiner's rejection of claims 13-17, Applicants have amended claims 13 in the manner suggested by the Examiner. Accordingly, Applicants requested that this rejection be withdrawn.

III. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-9 and 12-18 under 35 U.S.C. § 103(a) as being obvious over Lim U.S. Patent No. 5,980,584 (Lim 1), in view of Akram U.S. Patent No. 5,230,710 (Akram). According to the Examiner, Lim 1 teaches the compound 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol as a primary intermediate and discloses that the primary intermediate may be used in combination with a coupler, including 2,6-bis(hydroxyethylamino)toluene as well as 2,4-diaminophenoxyethanol. The Examiner acknowledges that Lim 1 exemplifies various compositions which contain the compound 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol, which is within the scope of formula (1) in combination with a coupler 2-hydroxyphenyl)ethane-1,2-diol that is outside the scope of the penalty claimed coupler. Thus, the Examiner indicated that Lim 1 does not provide an example of the process or combination claims, particularly one which uses the claimed coupler.

The Examiner also argues that Akram teaches 2,6-diaminotoluenes for use as couplers in combination with a developer for dyeing keratin fibers. Akram's preferred couplers include 2,6-bis(hydroxyethylamino)toluene. The Examiner also notes that Akram teaches that the disclosed couplers are an improvement over conventional coloring agents because they produce stable, bright, intense colorings, and because they have improved resistance to various agents including perspiration, acid rain, detergents, sunlight, and UV radiation.

As a result, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to select 2,6-bis(hydroxyethylamino)toluene for use as a coupler in combination with 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol developer, as allegedly taught by Lim 1, to obtain a dyeing composition and process as claimed in the present invention. The Examiner reached this conclusion because Lim 1 allegedly teaches the claimed coupler as being suitable for use in the Applicants' composition and Akram teaches the beneficial properties of the claimed coupler, thus motivating one of ordinary skill in the art to select 2,6-bis(hydroxyethylamino)toluene for use in the composition disclosed by Lim 1.

Applicants respectfully traverse this rejection. The PTO has failed to establish a *prima facie* case of obviousness, because the references, either alone or in combination, do not teach or suggest all of the limitations of the claims. See In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Assuming, *arguendo*, that Lim 1 and Akram teach that which the Examiner alleges, neither Lim 1 nor Akram teach the use of an oxidation base *other than* those chosen from pyrimidine, pyrimidine derivatives, 2- β -hydroxyethyl-para-phenylenediamine, and addition salt thereof with an acid. See claim 1. Lim 1 and Akram teach oxidation bases in general and do not exclude the use of any particular oxidation base, yet alone those excluded in the present invention.

More importantly, the compositions for dyeing hair set forth in Lim 1 that are pointed to by the Examiner, i.e., Examples 3 and 8, all contain N-N-Bis(2-hydroxyethyl)-p-phenylenediamine, a coupler specifically excluded from the language of claim 1. See Tables 6 and 7 of Lim 1. Applicants point out that Table 1 merely discloses preferred combinations of primary intermediates and couplers, none of which are within the scope of the presently claimed

invention. Importantly, these combinations are then combined with additional components to form a dyeing combination. Tables 6 and 7 show that these other components include couplers specifically excluded by independent claims 1, 13 and 18.

Since Lim 1 and Akram do not teach all of the limitations of the claims, they do not, either alone, or in combination, render the present invention obvious. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

The Examiner has also rejected claims 1-18 under 35 U.S.C. § 103(a) as being obvious over Lim U.S. Patent 6,074,438 (Lim 2) in view of Akram. According to the Examiner, Lim 2 teaches an exemplifies compositions for dyeing hair which contain the claimed oxidation base 2-chloro-4-aminophenol in the claimed amounts as well as a pyrazolone coupler. Furthermore, the Examiner contends that Lim 2 teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including 2,6-bis(hydroxyethylamino)toluene, as well as direct dyes and additional p-aminophenol oxidation bases. Finally, the Examiner argues that Lim 2 teaches that the compositions may be packaged in kits. However, Lim 2 does not teach a composition, process, or kit as presently claimed, particularly one which contains or uses the claimed coupler.

The Examiner relies on the teaches of Akram, as discussed above.

In the Examiner's view, it would have been obvious to one of ordinary skill in the art to formulate a composition for dyeing hair which contains an oxidation base and a coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in kits as claimed, and is applied to hair in a dyeing process as claimed because such compositions, processes, and kits fall within the

scope of Lim 2. The Examiner also contends that it would have been obvious to select 2,6-bis(hydroxyethylamino)toluene as the preferred coupler because Lim 2 teaches the claimed coupler and Akram teaches that the claimed coupler is preferred and results in various improved dyeing properties.

Applicants respectfully traverse this rejection. The 2-chloro-4-aminophenol pointed to by the Examiner is outside the scope of the presently claimed at least one oxidation base. In independent claims 1, 13, and 18, R₁ is chosen from hydrogen, fluorine, C₁-C₄ alkyl radicals, C₁-C₄ monohydroxyalkyl radicals, C₂-C₄ polyhydroxyalkyl radicals, C₁-C₄ alkoxyalkyl radicals, C₁-C₄ aminoalkyl radicals, and monohydroxy (C₁-C₄) alkylamino (C₁-C₄) alkyl radicals. It is clear that the oxidation base of the present invention cannot be 2-chloro-4-aminophenol because R₁ cannot be chlorine. Accordingly, Lim 2, which teaches 2-chloro-4-aminophenol, does not teach the oxidation bases of the present invention and, therefore, does not render the present invention obvious.

Akram does not cure the deficiencies of Lim 2. Assuming, *arguendo*, that Akram does teach a preference for 2,6-bis(hydroxyethylamino)toluene, Akram does not teach use of an oxidation base within the scope of the present invention, or the exclusion of pyrimidine, pyrimidine derivatives, 2-β-hydroxyethyl-para-phenylenediamine, and addition salt thereof with an acid, as oxidation bases.

As a result, Lim 2, in view of Akram, does not teach all of the limitations of the claims. Accordingly, the references do not render the present invention obvious and the rejection should be withdrawn.

IV. DOUBLE PATENTING REJECTION

The Examiner has *provisionally* rejected claims 1-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/443,142 ("the '142 application") and claims 1-32 of copending Application No. 09/443,506 ("the '506 application"). The Examiner argues that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending applications recite keratin fiber dyeing compositions which contain at least one oxidation base and the claimed 1,3-bis(β -hydroxyethyl)amino-2-methyl benzene coupler, wherein the oxidation bases and couplers may be present in the claimed amounts. The Examiner also argues that the composition may be used in a keratin fiber dyeing process as claimed, and may be packaged in multi-compartment kits. Finally, the Examiner argues that the oxidation bases in the copending applications may be p-aminophenol oxidation bases. Accordingly, the Examiner contends that the instantly claimed compositions, processes, and kits are therefore obvious over the claims of the '142 and '506 applications.

While not agreeing to the propriety of this rejection and insofar as this rejection is provisional, Applicants respectfully request that this rejection be held in abeyance until allowable subject matter is indicated in the instant application. Until such time, Applicants reserve the right to traverse the rejection or file a terminal disclaimer.

V. CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are directed to allowable subject matter. An early and favorable action is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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